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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,485	01/21/1999	SHUJI OTSUKA	102624	6019

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 09/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/234,485

Applicant(s)

OTSUKA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/10/03 & 7/9/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5,7-13 and 18 is/are allowed.
- 6) ☒ Claim(s) 14-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 20.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendments were received on 6/10/03 and 7/9/03, and have been entered and made of record. Currently, **claims 1-3, 5, and 7-20** are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 14-17, 19, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Witek (U.S. Patent Number 5,461,488).

Regarding *claim 14*, Witek discloses a *network* facsimile machine (see Fig. 1) capable of executing facsimile transmission via a *computer network* to an addressee (see abstract) using a computer (computer 12) installed with an application program for execution of *network* facsimile transmission (interpreted as the electronic mail program 20), comprising analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic mail application program (OCR program 16 and custom pattern recognition 18, column 3, lines 3 through 62) which is already in operation (column 3, lines 21 through 36), reading means for reading the data of address information analyzed by the analyzing means (column 3, lines 37 through 62), wherein the data of address information for a first address of the addressee is

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distinguished from the data of address information for a second address of the addressee (column 3, lines 21 through 62), and format converting means for converting the read data of address information into address information with a format used on the application program for execution of *network* facsimile transmission (column 3, lines 63 through column 4, line 9, and column 6, lines 60 through 66), wherein the application program for execution of *network* facsimile transmission (e-mail program 20) and the electronic mail application program (OCR program 16 and custom pattern recognition 18) are independently operating application programs using the computer (see Fig. 1, and column 4, lines 20 through 31).

However, Witek does not specifically teach if the *network* is an internet, and subsequently if the network facsimile transmission is an internet facsimile transmission. Contrarily, Witek does teach that the network can be “any like computer communication means to transmit the faxes received by modem 10 to the destinations identified by the customer pattern recognition code 18” (as read on column 3, line 65 through column 4, line 9). Further, it was well known in the art that electronic mail is typically transmitted over the Internet. Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the “office network” taught by Witek as being an internet, thereby executing an internet facsimile transmission operation. By considering Witek’s computer network as the Internet, facsimile transmissions would be able to have standard e-mail destinations to any global recipient over the Internet, thereby making the system available and open to more users.

Regarding *claim 15*, Witek discloses the facsimile machine discussed above in claim 14, and further teaches of means for storing the data of address information converted by the format converting means as an addressee address for the facsimile transmission via the *network* (column

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3, lines 21 through 36) and address selecting means for selecting a desired address from the address information storage means (column 3, lines 21 through 62). As discussed above, Witek does not specifically teach if the *network* is an internet, and subsequently if the network facsimile transmission is an internet facsimile transmission. Contrarily, Witek does teach that the network can be “any like computer communication means to transmit the faxes received by modem 10 to the destinations identified by the customer pattern recognition code 18” (as read on column 3, line 65 through column 4, line 9). Further, it was well known in the art that electronic mail is typically transmitted over the Internet. Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the “office network” taught by Witek as being an internet, thereby executing an internet facsimile transmission operation. By considering Witek’s computer network as the Internet, facsimile transmissions would be able to have standard e-mail destinations to any global recipient over the Internet, thereby making the system available and open to more users.

Regarding *claim 16*, Witek discloses the facsimile machine discussed above in claim 14, and further teaches that the electronic mail application program is in operation on the computer installed with the application program for execution of *network* facsimile transmission (column 2, line 16 through column 3, line 62) or a computer other than the computer installed with the application program for execution of internet facsimile transmission. As discussed above, Witek does not specifically teach if the *network* is an internet, and subsequently if the network facsimile transmission is an internet facsimile transmission. Contrarily, Witek does teach that the network can be “any like computer communication means to transmit the faxes received by modem 10 to the destinations identified by the customer pattern recognition code 18” (as read on column 3,

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line 65 through column 4, line 9). Further, it was well known in the art that electronic mail is typically transmitted over the Internet. Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the “office network” taught by Witek as being an internet, thereby executing an internet facsimile transmission operation. By considering Witek’s computer network as the Internet, facsimile transmissions would be able to have standard e-mail destinations to any global recipient over the Internet, thereby making the system available and open to more users.

Regarding *claim 17*, Witek discloses the facsimile machine discussed above in claim 15, and further teaches that the electronic mail application program is in operation on the computer installed with the application program for execution of *network* facsimile transmission (column 2, line 16 through column 3, line 62) or a computer other than the computer installed with the application program for execution of internet facsimile transmission. As discussed above, Witek does not specifically teach if the *network* is an internet, and subsequently if the network facsimile transmission is an internet facsimile transmission. Contrarily, Witek does teach that the network can be “any like computer communication means to transmit the faxes received by modem 10 to the destinations identified by the customer pattern recognition code 18” (as read on column 3, line 65 through column 4, line 9). Further, it was well known in the art that electronic mail is typically transmitted over the Internet. Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the “office network” taught by Witek as being an internet, thereby executing an internet facsimile transmission operation. By considering Witek’s computer network as the Internet, facsimile transmissions

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would be able to have standard e-mail destinations to any global recipient over the Internet, thereby making the system available and open to more users.

Regarding *claim 19*, Witek discloses a *network* facsimile machine (see Fig. 1) capable of executing facsimile transmission via a *computer network* to an addressee (see abstract) using a computer (computer 12) installed with an application program for execution of *network* facsimile transmission (interpreted as the electronic mail program 20), comprising an analyzing circuit for analyzing a data structure of data of address information registered on the basis of an electronic mail application program (OCR program 16 and custom pattern recognition 18, column 3, lines 3 through 62) which is already in operation (column 3, lines 21 through 36), a reading circuit for reading the data of address information analyzed by the analyzing circuit (column 3, lines 37 through 62), wherein the data of address information for a first address of the addressee is distinguished from the data of address information for a second address of the addressee (column 3, lines 21 through 62), and a format converting circuit for converting the read data of address information into address information with a format used on the application program for execution of *network* facsimile transmission (column 3, lines 63 through column 4, line 9, and column 6, lines 60 through 66), wherein the application program for execution of *network* facsimile transmission (e-mail program 20) and the electronic mail application program (OCR program 16 and custom pattern recognition 18) are independently operating application programs using the computer (see Fig. 1, and column 4, lines 20 through 31).

However, Witek does not specifically teach if the *network* is an internet, and subsequently if the network facsimile transmission is an internet facsimile transmission. Contrarily, Witek does teach that the network can be “any like computer communication means

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to transmit the faxes received by modem 10 to the destinations identified by the customer pattern recognition code 18” (as read on column 3, line 65 through column 4, line 9). Further, it was well known in the art that electronic mail is typically transmitted over the Internet. Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the “office network” taught by Witek as being an internet, thereby executing an internet facsimile transmission operation. By considering Witek’s computer network as the Internet, facsimile transmissions would be able to have standard e-mail destinations to any global recipient over the Internet, thereby making the system available and open to more users.

Regarding *claim 20*, Witek discloses a recording medium (memory 13, column 2, lines 16 through 41) for recording a program for operating a facsimile machine (see Fig. 1) using a computer (computer 12) installed with an application program for execution of *network* facsimile transmission (interpreted as the electronic mail program 20), with the program realizing the functions of analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic application program (OCR program 16 and custom pattern recognition 18, column 3, lines 3 through 62) which is already in operation (column 3, lines 21 through 36), reading means for reading the data of address information analyzed by the analyzing means (column 3, lines 37 through 62), wherein the data of address information for a first address of the addressee is distinguished from the data of address information for a second address of the addressee (column 3, lines 21 through 62), and format converting means for converting the read data of address information into address information with a format used on the application program for execution of *network* facsimile transmission (column 3, lines 63 through column 4, line 9, and column 6, lines 60 through 66), wherein the application program

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for execution of *network* facsimile transmission (e-mail program 20) and the electronic mail application program (OCR program 16 and custom pattern recognition 18) are independently operating application programs using the computer (see Fig. 1, and column 4, lines 20 through 31).

However, Witek does not specifically teach if the *network* is an internet, and subsequently if the network facsimile transmission is an internet facsimile transmission. Contrarily, Witek does teach that the network can be “any like computer communication means to transmit the faxes received by modem 10 to the destinations identified by the customer pattern recognition code 18” (as read on column 3, line 65 through column 4, line 9). Further, it was well known in the art that electronic mail is typically transmitted over the Internet. Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the “office network” taught by Witek as being an internet, thereby executing an internet facsimile transmission operation. By considering Witek’s computer network as the Internet, facsimile transmissions would be able to have standard e-mail destinations to any global recipient over the Internet, thereby making the system available and open to more users.

Allowable Subject Matter

4. **Claims 1-3, 5, 7-13, and 18** are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter:

Regarding ***claims 1 and 18***, in the examiner’s opinion, it would not have been obvious at the time the invention was made to have the system, as claimed include a means or circuit, provided at the computer side for displaying the addressee identification information fetched out

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of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee identification information is selected. The closest prior art, Houghton *et al.* (U.S. Patent Number 6,009,153), Feder (U.S. Patent Number 5,872,845), and Rachelson (U.S. Patent Number 6,157,706), each fail to specifically teach of displaying, at the computer side, the addressee identification information fetched out of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee identification information is selected. This limitation, which was added in the amendment dated 11/18/02, renders the claims allowable.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. P. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp


EDWARD COLES
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